

# REMARKS

## I. CLAIM OBJECTION

Claims 3 to 9 were objected to under 37 CFR 1.75 (c) for being in an improper form because of improper multiple claim dependencies.

Claims 1 to 12, including claims 3 to 9, have been canceled, obviating the objection to the form of claims 3 to 9.

New claims 13 to 29 have been filed, but do not include multiple claim dependencies.

It is respectfully submitted that new claims 13 to 29 should not be objected to under 37 CFR 1.75 (c) for being in an improper form.

## II. INDEFINITENESS REJECTION

Claims 7 to 12 were rejected under 35 U.S.C. 112, second paragraph, as indefinite.

Claims 7 to 12 were “use” claims, which were in an improper statutory form and which did not recite a single positive step delimiting their use.

New method claims 22 to 29 have been added and “use” claims 7 to 12 have been canceled. The new main method-of-use claim 22 recites two positive steps delimiting the claimed method. The first step is the step of providing a special cosmetic agent made by covalently linking a peptide with a known organic cosmetic effector compound, which advantageously is a hair dye (claims

25 and 26). The second step comprises applying the cosmetic agent made to parts of a human or animal body to perform the cosmetic treatment, particularly applying the cosmetic agent provided in the first step to hair to dye the hair. The basis for the positively recited steps in new claim 22 is found e.g. on page 17, next to last paragraph; page 2, last three lines, of the fourth full paragraph and first paragraph on page 4, of the applicants' U.S. specification.

Thus the new method claims include positively recited steps of a method so that it is respectfully submitted that the new method claims 22 to 29 should not be rejected under 35 U.S.C. 112, second paragraph, for indefiniteness.

### **III. NONSTATUTORY CLAIMS**

Claims 7 to 12 were in the form of "use" claims. This claim form is of course not permitted under U.S. Patent Law.

None of the new claims 13 to 29 are in a claim form that is not permitted in U.S. Patent Practice.

Thus new claims 13 to 29 should not be rejected under 35 U.S.C. 101.

### **IV. SPECIFICATION AND ABSTRACT**

A number of changes were made in the specification to provide a specification in a form that complies with rules and recommendations in US Patent Office Rules and correct errors in the English translation.

A cross-reference to the corresponding International Application and DE priority document has been added to the first page of the specification.

Page 17 of the specification has been corrected to delete the duplicate listing of the term “lotion”.

Page 2 of the specification has been corrected to eliminate a reference to the claims by number, which is not permitted by U.S. Patent Office rules.

Standard section headings have been added as recommend by U.S. Patent Office Rules.

An entire line of text was inadvertently omitted from the bottom of page 16 of the English translation. The paragraph running from page 16 to 17 has been corrected in accordance with 37 C.F.R. 1.57 (a) by including the missing subject matter by the above changes since the filing date of the above-identified U.S. Patent Application is October 18, 2004 (which is after September 21, 2004 – see MPEP 201.17).

Since the Declaration of Inventorship in the above-identified U.S. Patent application refers to the international application, PCT/EP 0305021, and makes a claim of priority of invention based on the international application as of the filing date, the present application is entitled to correct the English translation of the specification by adding the omitted part under 37 C.F.R.1.57 (a). The omitted line of text was clearly inadvertently omitted from the English translation.

The missing or omitted material appears in the last line of page 20 and the first line of page 21 of the original German language specification and is in German “oder Alginate), weitere Haar- und Hautpflegestoffe (wie zum Beispiel, Zucker, Proteine,”.

An English translation of the specification was supplied but the translation

of the omitted material was of course not present. It is respectfully submitted that another English translation should not be required because the chemical names and some of the other wording above is almost the same as in the English language (for example “Proteine” means “proteins”, “Zucker” means “sugar”, “alginate” is the same in English and German, “Hautpflege” means “skin care”, etc).

The abstract was amended to provide an abstract of the disclosure that summarizes the subject matter of the new claims 13 to 29.

## **V. NEW CLAIMS**

New cosmetic agent claim 13 claims a cosmetic agent including a cosmetic auxiliary agent as well as the cosmetically active compound formed by covalently linking organic cosmetic effector molecules with peptidic linker molecules. The basis for the added cosmetic auxiliary ingredient is found in the paragraph that runs from page 16 to 17 of the applicants' specification. The basis for the “acts as a binding agent” wording in claim 13 is found in the fifth full paragraph on page 2 of applicants' specification.

New cosmetic agent claim 13 (last paragraph) also limits the claimed cosmetic agent to effector molecules with the preferred cosmetic properties recited in canceled claim 4.

Dependent agent claim 14 includes new subject matter. Basis for dependent agent claim is found in the first paragraph on page 4 of applicants' specification.

Basis for claims 15 and 16 is found in the first paragraph on page 16 of applicants' specification.

The first full paragraph on page 10 of applicants' specification provides the basis for the new cosmetic agent claim 18.

Canceled claim 6 provides the basis for the new agent claims 19 to 21.

The new main method claim 22 has basis e.g. in canceled claims 77, 8 and 10 and e.g. on page 17, next to last paragraph; page 2, last three lines, of the fourth full paragraph and first paragraph on page 4, of the applicants' U.S. specification.

Basis for dependent claim 24 is found in the first paragraph on page 4 of applicants' specification. Basis for dependent claims 25 and 26 appears in first full paragraph on page 10 of applicants' specification. New dependent claims 27 and 28 contain subject matter from canceled claims 4 and 5. Claim 29 includes subject matter from the paragraph running from page 16 to 17.

## **VI. ANTICIPATION REJECTION**

Claims 1 to 2 were rejected as anticipated under 35 U.S.C. 102 (b) by WO 02/29407 A2 (Cook).

WO '407 (Cook) is a reference that is not from the cosmetic arts, but instead discloses new dye-labeled peptide derivatives (claim 1) and methods of detecting the presence of a biological material (claims 14 to 15), particularly the presence of a protease enzyme, using the new peptide derivatives (see example 3, page 28, of this WO reference).

Cook does teach one or more fluorescent dye molecules covalently bonded to various peptide chains. However Cook does not disclose or suggest that the peptide chains can act as linking agents for linking or bonding the dye molecules to parts of a human or animal body that contain keratin-material, which is the key feature of the present invention.

Cook does not disclose or suggest cosmetic compounds with the claimed cosmetic properties or methods of performing a cosmetic treatment of any kind. Hence Cook does not disclose or suggest the method claimed in claims 22 to 29.

Cook does not disclose or suggest the new cosmetic agent claims 13 to 21 because they claim a cosmetic agent comprising two components. One of the components is a cosmetic auxiliary agent that is typically included in various cosmetic compositions. This auxiliary agent can be a thickener, vitamin, provitamin, antigrease agent, antioxidant, preservative, perfume or an inorganic pigment.

Cook does **not** disclose a composition that contains any of these cosmetic auxiliary agents as claimed in new claim 13. Hence Cook does not disclose any of the new cosmetic agent claims 13 to 21.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

For the foregoing reasons and because of the new wording in the new

claims it is respectfully submitted that the new claims 13 to 29 should **not** be rejected under 35 U.S.C. 102 (b) as anticipated by WO 02/29407 A2 (Cook).

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

**/ Michael J. Striker /**

Michael J. Striker,

Attorney for the Applicants

Reg. No. 27,233